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MEMORANDUM

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TO: GROUP 2672 DIRECTOR

FROM: BOARD OF PATENT APPEALS AND
INTERFERENCES

SUBJECT: ORDER REMANDING TO EXAMINER

JAN - 7 2005

DIRECTOR OFFICE
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We are forwarding this application to
your Group for taking further action
consistent with the decision of the Board
remanding this appeal to the Primary Examiner.

Program & Resource Administrator
Board of Patent Appeals and Interferences
308-9797

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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAMRAN AHMED

Appeal No. 2004-1611
Application 09/526,442

ON BRIEF

Before KRASS, FLEMING, and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

REMAND TO THE EXAMINER

This is an appeal from the final rejection of claims 1-7, which are all of the claims pending in this application.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of the rejections and appropriate action with respect to the matters discussed below. Accordingly,

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37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

According to the Examiner (answer, pages 3-5), claims 1-7 are rejected under the first paragraph of 35 U.S.C. § 112 as containing subject matter which was not described in the specification in such a way to convey Appellant's possession of the claimed invention at the time the application was filed. The Examiner refers to Appellant's amendment to claim 1 which changed the limitation of "combine (blend and/or overlay) the at least two first (second) surfaces" to "at least one of blend and overlay the at least two first (second) surfaces" (answer, page 3). However, the Examiner states that this claimed invention is not supported by the originally filed specification as the specification did not describe the display controller as performing both blending and overlaying one surface to another (answer, page 4). The Examiner further asserts that the specification does not describe how the display controller can both blend and overlay two surfaces (answer, page 5).

In order to determine whether the specification adequately describes the claimed invention, we initially note Appellant's arguments (brief, pages 9-11 and reply brief, pages 6-8) with respect to the amendment filed on May 13, 2003 which was denied

entry by the Examiner as containing new subject matter. It appears that this proposed, but not entered, amendment would have described the blending and overlaying of one surface onto another surface. We find the lack of written description and the new matter dispute to be peculiar since the Examiner has already permitted entry of a previous amendment (filed on December 3, 2002) which changed "combine (blend and/or overlay) the at least two first (second) surfaces" to "combine (at least one of blending and overlaying) the at least two first (second) surfaces" in pages 2 and 3 of the specification. Entry of this amendment to the specification, which provided support for the claimed display controller as performing both blending and overlaying one surface to another, contradicts the Examiner's position with respect to the 35 U.S.C. § 112, first paragraph, rejection and the denied entry of the later filed amendment.

Although the issue of the Examiner's refusal to enter an amendment is not subject to appeal, and instead is a petitionable matter decided by the Technology Center Directors (see MPEP § 1002.02(c)), we consider the disputed subject matter to be closely relevant to the proposed 35 U.S.C. § 112 rejection. Therefore, we suggest that the Examiner fully consider the extent of the disclosure, both as originally filed and amended, and

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determine the scope of the new matter contained in the amendments to the specification before evaluating the propriety of a rejection under the first paragraph of 35 U.S.C. § 112. Even if the Examiner finds that the claimed invention is described in the specification, the Examiner should also make a determination as to whether the specification is enabling, i.e., whether one of ordinary skill in the art is enabled to make a controller that can both blend and overlay two surfaces.

Additionally, with respect to the 35 U.S.C. § 103 rejection, and based on the evidence of record, although some suggestion is present in the applied prior art, the mere fact that additional logic may be added (answer, pages 7 & 13) does not necessarily indicate using a second display controller and the additional features pointed out by the Examiner. The Examiner is reminded that, even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000), citing B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996). If the Examiner finds that such evidence is present in the applied prior art, the Examiner is required to point to the relevant portions of the

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reference or present a clear line of reasoning in support of such conclusion. Otherwise, the Examiner should reconsider the rejection and/or apply additional prior art reference(s) in rejecting the claims. It is the Examiner and not this panel who has the burden of providing detailed fact finding with respect to the applied prior art and relevant analysis of the rejections based on such prior art in support of unpatentability of the claimed subject matter.

Our consideration of the record leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the Examiner for determining whether, in view of the entered amendments to the specification, the written description and/or enablement requirements of the first paragraph of 35 U.S.C. § 112 are complied with. Additionally, with respect to the 35 U.S.C. § 103 rejection, the Examiner is required to provide evidence of a second display controller or some teaching or suggestion in support of modifying the prior art to include one.

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This application, by virtue of its "special" status, requires an immediate action. See Manual of Patent Examining Procedure (MPEP) § 708.01 and 1211 (8th Ed., Rev. 2, May 2004). It is important that the board be informed promptly of any action affecting the appeal in this case.

REMANDED



ERROL A. KRASS)
Administrative Patent Judge)



MICHAEL R. FLEMING)
Administrative Patent Judge)



MAHSHID D. SAADAT)
Administrative Patent Judge)

) BOARD OF PATENT
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